

BS02301 CON 2

U.S. Application No. 10/717,892 Examiner Ramos Feliciano, Eliseo, Art Unit 2687
Response to 16 NOV 2004 Final Office Action

REMARKS

The United States Patent and Trademark Office (the "Office") objected to the Abstract for legal phraseology. The Office also objected to paragraphs [0002] and [0014] for informal mistakes. The Office objected to numerous claims for informalities and/or for improper dependency. Claims 6 and 14 were rejected under 35 U.S.C. § 112, second paragraph, for insufficient antecedent basis. Claims 1-19 were provisionally rejected under 35 U.S.C. § 101 for double patenting. Claims 1, 4-5, 8-12, and 16-19 were provisionally rejected under the judicially-created doctrine of obvious-type double patenting. Claims 1-2, 4-8, 10-12, 14-16, and 18-19 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,775,546 to Fuller in view of U.S. Patent 6,195,422 to Jones *et al.* Claims 3 and 13 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Fuller in view of Jones and further in view of U.S. Patent 5,933,785 to Tayloe. Claims 1, 9, 11, and 17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Fuller in view of published U.S. Patent Application 2003/005,0100 to Dent. The Assignee respectfully requests reconsideration and shows that the amended claims are neither anticipated nor obviated by the cited prior art. The Assignee, then, respectively submits that the pending claims 1-19 are patentably distinguishable over the cited prior art and are ready for allowance.

Objection to the Abstract

The United States Patent and Trademark Office (the "Office") objected to the Abstract for legal phraseology. The Abstract has been amended to remove the term "means."

Objection to the Specification

The Office objected to paragraphs [0002] and [0014] for informal mistakes. Paragraph [0002] has been amended to include the serial number of the referenced application. Paragraph [0014] has also been amended to include a closing parenthesis.

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Objection to the Claims

The Office objected to claims 1-2, 7, and 13-15 for informalities and/or for improper dependency. These claims have been extensively amended, thus the objection is moot.

Rejection of Claims Under 35 U.S.C. § 112

Claims 6 and 14 were rejected under 35 U.S.C. § 112, second paragraph, for insufficient antecedent basis. These claims have been extensively amended, thus the objection is moot.

Rejection of Claims under 35 U.S.C. § 101

Claims 1-19 were provisionally rejected under 35 U.S.C. § 101 for statutory double patenting. Claims 1-19, however, have been amended and do not resemble the claims of 10/648,525. The rejection is moot.

Rejection of Claims for Obvious-Type Double Patenting

Claims 1, 4-5, 8-12, and 16-19 were provisionally rejected under the judicially-created doctrine of obvious-type double patenting. Claims 1, 4-5, 8-12, and 16-19, however, have been amended and do not resemble the claims of 10/245,153. The rejection is moot.

Rejection of Claims 1-2, 4-8, 10-12, 14-16, and 18-19 Under 35 U.S.C. § 103

Claims 1-2, 4-8, 10-12, 14-16, and 18-19 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,775,546 to Fuller in view of U.S. Patent 6,195,422 to Jones *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed

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limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). Because the proposed combination of *Fuller* and *Jones* fails to teach or suggest all the features of the independent claims, and thus the dependent claims thereunder, the *prima facie* case of obviousness must fail.

The proposed combination of *Fuller* and *Jones* fails to obviate the claims. Independent claims 1 and 11 each include features for providing intelligent services to a call. The call originates from a native transport network and is directed to a virtual telephone number in a service-providing network. The service-providing network provides intelligent services to the call and then routes the call to a separate native transport network. As the call traverses the service-providing network, a duration of the call is monitored. Amended claim 1 is reproduced below.

1. A method for monitoring telecommunications usage, comprising:

receiving a call directed to a virtual telephone number in a service-providing network, the service-providing network providing intelligent services to said call;

routing said call to a separate native transport network from which said call originates; and

monitoring a duration of said call traversing the service-providing network.

Independent claim 11 includes similar features.

The proposed combination of *Fuller* and *Jones* fails to describe such features. *Fuller* and *Jones*, whether independently or jointly, fail to teach or suggest the features of independent claims 1 and 11. One of ordinary skill in the art, then, would not consider the pending claims obvious in view of *Fuller* and *Jones*. The proposed combination of *Fuller* and *Jones*, then,

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cannot obviate the independent claims, so the Assignee respectfully requests that the Examiner remove the 35 U.S.C. § 103 (a) of claims 1-2, 4-8, 10-12, 14-16, and 18-19.

Rejection of Claims 3 and 13 Under 35 U.S.C. § 103

Claims 3 and 13 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Fuller* in view of *Jones* and further in view of U.S. Patent 5,933,785 to Tayloe. The proposed combination of *Fuller*, *Jones*, and *Tayloe* still fails to describe all features of the independent base claims 1 and 11. *Fuller*, *Jones*, and *Tayloe*, whether independently or jointly, fail to teach or suggest the features of independent claims 1 and 11. One of ordinary skill in the art, then, would not consider the pending claims obvious in view of *Fuller*, *Jones*, and *Tayloe*. The proposed combination of *Fuller*, *Jones*, and *Tayloe*, then, cannot obviate the independent claims, so the Assignee respectfully requests that the Examiner remove the 35 U.S.C. § 103 (a) of claims 3 and 13.

Rejection of Claims 1, 9, 11, and 17 Under 35 U.S.C. § 103

Claims 1, 9, 11, and 17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Fuller* in view of published U.S. Patent Application 2003/005,0100 to Dent. The proposed combination of *Fuller* and *Dent* still fails to describe all features of the independent base claims 1 and 11. *Fuller* and *Dent*, whether independently or jointly, fail to teach or suggest the features of independent claims 1 and 11. One of ordinary skill in the art, then, would not consider the pending claims obvious in view of *Fuller* and *Dent*. The proposed combination of *Fuller* and *Dent*, then, cannot obviate the independent claims, so the Assignee respectfully requests that the Examiner remove the 35 U.S.C. § 103 (a) of claims 3 and 13.

Each Prima Facie Case of Obviousness Fails for Lack of Teaching, Suggestion, or Motivation

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All the Examiner's attempted *prima facie* cases for obviousness fail to establish any teaching, suggestion, or motivation. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). **When the motivation to combine the teachings is not apparent, the Examiner has a duty to explain why the combination is proper.** See *id.* at 2142; see also *In re Skinner*, 2 U.S.P.Q.2d (BNA) 1788 (Bd. Pat. App. & Inter. 1986) (emphasis added). **Even if the references teach all aspects of the claimed invention, the Examiner's *prima facie* case must still include some objective reason to combine the references.** See M.P.E.P. at § 2143.01; see also *In re Levengood*, 28 U.S.P.Q.2d (BNA) 1300 (Bd. Pat. App. & Inter. 1993) (emphasis added).

Here, the office action fails to identify any teaching, suggestion, or motivation to combine the cited references. The Examiner makes no effort to explain why each proposed combination is proper. Because the Examiner has failed to carry the initial burden of factually supporting each *prima facie* conclusion of obviousness, the Examiner is required to either i) supplement the rejection in the next office action or ii) remove the rejection. If the Examiner chooses to supplement the rejection in the next office action, that next office action cannot be made final without violating the Assignee's Due Process rights.

Each *Prima Facie* Case of Obviousness Fails for Lack of Expectation of Success

All the Examiner's attempted *prima facie* cases for obviousness fail to establish any expectation of success. If the Office wishes to establish a *prima facie* case of obviousness, the Examiner must identify a reasonable expectation of success. See DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

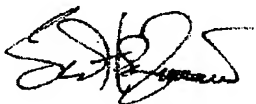
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Here, the office action fails to identify any expectation of success. The Examiner makes no effort to explain why one of ordinary skill in the art would expect success when attempting to combine the references. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,



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